



AF/1752
JFW

MS APPEAL BRIEF - PATENTS
PATENT
1982-129P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals
Toru MATAMA Appeal No.:

Appl. No.: 09/374,989 Group: 1752
Filed: August 16, 1999 Examiner: A. Walke
Conf.: 4436
For: PHOTOGRAPHIC PHOTSENSITIVE MATERIAL AND
 PHOTOGRAPHIC PRINTING SYSTEM

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 25, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on April 28, 2004.

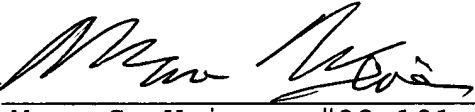
☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

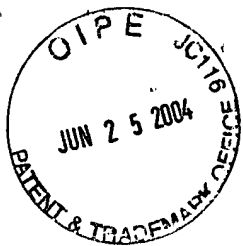
Marc S. Weiner, #32,181 *HNS*

MSW/HNS/lab
1982-129P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s)

(Rev. 02/12/2004)



Appl No: 09/374,989
Attorney Docket: 1982-129P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Toru MATAMA Conf.: 4436
Appl No: 09/374,989 Art Unit: 1752
Filed: August 16, 1999 Examiner: Amanda Walke
For: PHOTOGRAPHIC PHOTSENSITIVE MATERIAL AND
PHOTOGRAPHIC PRINTING SYSTEM

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 25, 2004

Sir:

In reply to the Examiner's Answer dated April 28, 2004, the following remarks are respectfully submitted in connection with the above-identified application as follows.

BOHAN DOES NOT AFFIRMATIVELY PROHIBIT BOTH MASKING COUPLER AND
DIR COUPLER AT THE SAME TIME

Bohan et al. (USPN 5,837,433, hereinafter "Bohan") discloses a method of providing a color image using color silver halide emulsion layers which have chemical based color corrections by masking compounds and Development Inhibitor Releasing (DIR) compounds. Bohan discloses that a film may be digitally scanned and printed when digital processing occurs.

The Examiner admits that Bohan discloses a color negative material which may include both masking coupler and/or Development Inhibitor Releasing (DIR) couplers. See *Examiner's Answer*, page 4, lines 5-9. However, there is clearly **no affirmative prohibition** of both masking compounds and DIR compounds from being present at the same time. Therefore, by the Examiner's own admission, Bohan simply cannot teach or suggest that "said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time."

In the Examiner's Answer, the Examiner asserts that Bohan provides examples of materials which only contain DIR couplers. More specifically, the Examiner states:

... the first three examples of the [Bohan] reference demonstrate a material that only contains the DIR coupler. Masking couplers C2, C3, and C6, are not present in those exemplified materials. Thus, the reference *clearly* contemplates employing either the masking coupler OR the DIR coupler, and not solely both simultaneously. See *Examiner's Answer*, page 7, lines 12-15.

It appears that the Examiner is referring to Photographic Samples 1-3 in columns 24-26 of Bohan. The Examiner should note

the description at column 25, lines 56-59 of Bohan. This description **completely contradicts the Examiner's position** that "Masking couplers ... are not present in those exemplified materials." See *Examiner's Answer*, page 7, line 13. Similarly, note column 26, lines 5-8 and lines 22-24. Clearly, some amount of color masking coupler is present in Photographic Samples 1-3, contrary to the position taken by the Examiner.

On the other hand, if the Examples to which the Examiner refers are the embodiments as shown in Figures 1-3 of Bohan, the Examiner's assertions are again factually incorrect. For example, the Examiner is incorrect with regard to the film structure of Figure 1. Bohan specifically teaches that layers 5, 6, and 7 typically include both DIR couplers and cyan dye-forming magenta and yellow masking couplers and that layers 9, 10, and 11 also typically include both DIR couplers and magenta dye-forming yellow masking couplers. See *Bohan*, column 11, lines 52-55 and 62-65.

The Examiner is also factually incorrect with regard to the film structure of Figure 3. Bohan teaches that layers 28 and 29 typically include both DIR couplers and yellow dye-forming cyan and magenta masking compounds and that layers 33, 34, and 35

typically includes both DIR couplers and cyan dye-forming magenta masking compounds. See Bohan, column 12, lines 51-55 and column 13, 7-11.

More importantly, even if the Examiner's characterization is taken at face value, it still **does not** illustrate that Bohan affirmatively prohibits both the DIR and masking couplers functions being included at the same time.

The Examiner also relies on column 11, lines 16-26 of Bohan which states in part, "due to the inability of the art to provide adequate chemical based color corrections whether by masking compounds, or Development Inhibitor Releasing (DIR) compounds, such constraints are obviated by the digital scanning and color correction steps employed in specific embodiments of this invention." The Examiner relies on this statement and asserts that Bohan teaches use of one or both DIR and masking couplers, but not both.

In as far as the specifically relied upon portion is concerned, the Examiner has taken the statement out of context. Bohan specifically describes a problem in the art related to arranging a green or red light sensitive emulsion layer on one side of a film support and arranging a blue light sensitive

emulsion layer on the opposite side. See Bohan, column 11, lines 9-15. Bohan specifically indicates that such an arrangement is **avoided** in camera films intended for optical printing due to the inability of the art to provide adequate chemical based color corrections. Thus, when interpreted in the proper context, the relied upon portion indicates that the **avoidance** of physically arranging red or green layer on one side of the support and blue layer on the other side **is obviated**.

Indeed, Bohan states, "It is **additionally** contemplated that either general or color specific digital image sharpening be applied." Thus, when read in proper context, it is clear that Bohan contemplates using chemical based color correction mechanisms using DIR and masking couplers and **additionally using** digital processing.

The Examiner further maintains that the material of Bohan includes a unique processing step. See Examiner's Answer, page 8, lines 3-4. Clearly, the processing step is not unique if both chemical or digital processing may be utilized for the same material. Thus, the Examiner's statement that "the bar code ... would include information about ... its unique

processing information" cannot be true as well. See Examiner's Answer, page 8, lines 4-8.

Further, the Examiner states that Appellant, in page 11, line 16 of the Appeal Brief, admits Bohan is not required to contain a DIR coupler. Appellant invites the Examiner to review page 11, lines 15-17 of the Appeal Brief in which it is stated, "The Examiner admitted Bohan discloses the photographic material may contain an DIR coupler" and to lines 18-21 in which it is stated, "The Examiner also readily admitted that Bohan discloses photographic material may include color masking couplers." *Emphasis added.* Clearly, the Examiner's characterization is not accurate.

SUZUKI CANNOT TEACH IDENTIFICATION CODE

As the Examiner admits, Bohan fails to disclose, "a material having a bar code in it or on the cartridge encasing it." See Examiner's Answer, page 4, lines 9-10. To make up for this deficiency, the Examiner relies on Suzuki et al. (USPN 6,094,218, hereinafter "Suzuki").

Suzuki discloses a film with magnetic storage regions and bar code regions which may contain information limited to the

type of film, frame number, total number of frames and the film type. However, Suzuki teaches nothing with respect to providing specific information about whether or not the "photosensitive material has only one of or none of said color correcting function and said sharpness enhancing function."

Also the Examiner simply takes the position that "since the bar code of Suzuki et al may contain information relating to photography with respect to type of film contained in the cartridge, it would have been obvious to one of ordinary skill in the art to encode useful information relating to all photographic layers and additives therein." *See Examiner's Answer, page 8, lines 9-12.* Simply taking a position cannot substitute for the requirement of demonstrating proper motivation to be found within the cited art as required in M.P.E.P. 2143.01.

BOHAN AND SUZUKI NOT DEDICATED TO DIGITAL PROCESSING

The Examiner appears to be of the opinion that if a material **can** be processed digitally, then it is dedicated to digital processing regardless of whether the material is designed for conventional chemical processing.

As noted above, Bohan does not exclude conventional processing to develop images. Indeed, it has been shown that Bohan specifically contemplates digital processing in addition to chemical processing. In short, Bohan's film structures are **not** photographic photosensitive materials dedicated for digital data processing.

The Examiner states that "The ENTIRE disclosure of Bohan et al. references teaches and even requires that processing is not complete until a final product that has been through development processing AND digital processing is obtained." See *Examiner's Answer, page 9, line 22 - page 10, line 2*. The logic appears to be the following. Bohan teaches digitally processing a photographic material to achieve a finished product. Therefore, Bohan must teach a photographic material that is dedicated to digital processing.

Appellant respectfully submits that the Examiner's logic is faulty. Just because a material may be used in a particular process is not conclusive evidence that the material is dedicated for that particular process.

The Examiner also wrongly dismisses the inclusion of Pagano et al. (USPN 5,543,882, hereinafter "Pagano") in Bohan. Bohan

specifically discloses that photographic processing method and apparatus described in Pagano may be utilized. See *Bohan*, column 20, lines 39-42. Pagano is directed toward method and apparatus of developing a film in a cartridge in which the film is not detached from the cartridge while being processed. It should be noted that the developing of the film itself is quite conventional as described in Pagano. In other words, the film may be developed via chemical methods.

The Examiner dismisses this inclusion of Pagano by simply asserting that besides the particulars of the development processing step/method, the teachings of Pagano are irrelevant. See *Examiner's Answer*, page 10, lines 2-5. In other words, the Examiner is simply ignoring the teachings of Pagano as a whole. The Examiner also speculates that one of ordinary skill would ignore the teachings of Pagano as well, which is clearly unreasonable.

BOHAN AND NAIR DEFICIENT

The Examiner's reliance upon Nair et al. (USPN 5,723,426, hereinafter "Nair") is similar to her reliance upon Suzuki. See *Examiner's Answer*, page 10, line 8 - page 11, line 8. The

combination of Bohan and Nair suffers from at least similar deficiencies related to that of the combination of Bohan and Suzuki.

BOHAN DISCLOSES CONVENTIONAL FILM STRUCTURE LAYERS

The Examiner states that Bohan "teaches that silver halide material of the invention may contain any conventionally employed layers." *See Examiner's answer, page 11, lines 9-12.* Appellant fails to understand the significance of this statement. Indeed, to the extent that Bohan teaches anything **conventional**, it only bolsters the argument that Bohan may not be relied upon to teach or suggest a photographic material dedicated to digital processing and may not be relied upon to teach or suggest prohibiting both masking and DIR couplers at the same time.

CONCLUSION

It is respectfully requested that the outstanding rejections set forth in the Final Office Action be REVERSED.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

U.S. Application No. 09/374,989

Docket No. 1982-129P

June 25, 2004

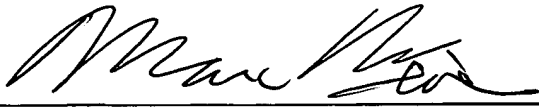
Art Unit: 1752

Page 11 of 11

fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly,
extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

Marc S. Weiner

Reg. No. 32,181 HNS

MSW/HNS/jm/lab
1928-0129P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000